

IN THE UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF DELAWARE

VOITH PAPER GMBH & CO. KG	:	
	:	Civil Action No. 07-226-JJF
Plaintiff,	:	
	:	
v.	:	
	:	
JOHNSONFOILS, INC.	:	
	:	
Defendant.	:	

**DEFENDANT, JOHNSONFOILS, INC.'S,  
SUPPLEMENTAL EXHIBITS IN SUPPORT OF ITS  
MOTION TO STAY THE PROCEEDINGS PENDING  
REEXAMINATION OF THE PATENTS IN SUIT  
OR IN THE ALTERNATIVE FOR LEAVE TO FILE  
A MOTION FOR SUMMARY JUDGMENT PRIOR TO AUGUST  
20, 2008 THAT U.S. PATENTS 5,718,805 AND 5,972,168 ARE INVALID**

Defendant, JohnsonFoils, Inc. ("JohnsonFoils") previously filed a "Motion to Stay The Proceedings Pending Reexamination Of The Patents In Suit Or In The Alternative For Leave To File A Motion For Summary Judgment Prior To August 20, 2008 That U.S. Patents 5,718,805 And 5,972,168 Are Invalid" (D.I. 27) (the "Motion to Stay"), which remains pending.

On January 28, 2008, JohnsonFoils was notified that the United States Patent and Trademark Office ("USPTO") has granted reexamination to U.S. Patent No. 5,389,206, a related patent to the Patents-in-Suit. With the USPTO's recent order, the USPTO has ordered reexamination of the Patents-in-Suit and all related patents. Accordingly, JohnsonFoils is submitting the USPTO's five (5) Reexamination Orders to complete the record for the pending Motion to Stay. See Exhibits 7, 8, 9, 10 and 11.<sup>1</sup>

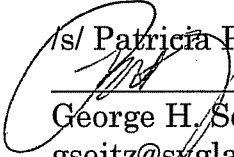
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<sup>1</sup> U.S. Patent Nos. 5,389,206, 5,500,091, and 5,853,544 are related to the Patents-in-Suit and are also the subject of JohnsonFoils pending "Motion for Leave to Amend Its Counterclaims." D.I. 57.

Dated: January 30, 2008

Respectfully submitted,

Seitz, Van Ogtrop & Green, P.A.

 /s/ Patricia P. McGonigle

George H. Seitz, III (DE #667)

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Patricia Pyles McGonigle (DE #3126)

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- and -

Anthony S. Volpe

John J. O'Malley

Volpe and Koenig, P.C.

United Plaza, Suite 1600

30 South 17<sup>th</sup> Street

Philadelphia, PA 19103

*Attorneys for Defendant*

*JohnsonFoils, Inc.*

**CERTIFICATE OF SERVICE**

I, Patricia P. McGonigle, Esquire, hereby certify that on this 30<sup>th</sup> day of January 2008, I electronically filed the foregoing pleading with the Clerk of Court using CM/ECF which will send notification of such filing to counsel of record. Further, I caused a copy of the foregoing pleading to be served upon the following counsel as noted

**Via Hand Delivery**

Adam W. Poff, Esquire  
Young, Conaway, Stargatt & Taylor, LLP  
1000 West Street, 17<sup>th</sup> Floor  
P. O. Box 391  
Wilmington, DE 19899

**Via Federal Express**

Neil F. Greenblum, Esquire  
Neal Goldberg, Esquire  
Michael J. Fink, Esquire  
Greenblum & Bernstein, PLC  
1950 Roland Clarke Place  
Reston, Virginia 20191

  
/s/ Patricia P. McGonigle

Patricia P. McGonigle (ID No. 3126)  
pmcgonigle@svglaw.com

# **Exhibit 7**



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
www.uspto.gov

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VOLPE & KOENIG, P.C.

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Volpe and Koenig, P.C.  
United Plaza, Suite 1600, 30 South 17<sup>th</sup> Street  
Philadelphia, PA 19103

## EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/008,826.

PATENT NO. 5718805.

ART UNIT 3991.

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified *ex parte* reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the *ex parte* reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).



## UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
 United States Patent and Trademark Office  
 Address: COMMISSIONER FOR PATENTS  
 P.O. Box 1450  
 Alexandria, Virginia 22313-1450  
 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,826	08/24/2007	5718805		2050

7590 11/19/2007  
 OSTROLENK FABER GERB & SOFFEN  
 1180 AVENUE OF THE AMERICAS  
 NEW YORK, NY 10036-8403

EXAMINER

ART UNIT PAPER NUMBER

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DATE MAILED: 11/19/2007

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VOLPE & KOENIG, P.C.

Please find below and/or attached an Office communication concerning this application or proceeding.

**Order Granting / Denying Request For  
Ex Parte Reexamination**

Control No.

90/008,826

Patent Under Reexamination

5718805

Examiner

Alan Diamond

Art Unit

3991

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

The request for *ex parte* reexamination filed 24 August 2007 has been considered and a determination has been made. An identification of the claims, the references relied upon, and the rationale supporting the determination are attached.

Attachments: a) ☐ PTO-892, b) ☒ PTO/SB/08, c) ☐ Other: RECEIVED AM/PM  
NOV 26 2007

1. ☒ The request for *ex parte* reexamination is GRANTED.

RESPONSE TIMES ARE SET AS FOLLOWS:

For Patent Owner's Statement (Optional): TWO MONTHS from the mailing date of this communication (37 CFR 1.530 (b)). **EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).**

For Requester's Reply (optional): TWO MONTHS from the **date of service** of any timely filed Patent Owner's Statement (37 CFR 1.535). **NO EXTENSION OF THIS TIME PERIOD IS PERMITTED.** If Patent Owner does not file a timely statement under 37 CFR 1.530(b), then no reply by requester is permitted.

2. ☐ The request for *ex parte* reexamination is DENIED.

This decision is not appealable (35 U.S.C. 303(c)). Requester may seek review by petition to the Commissioner under 37 CFR 1.181 within ONE MONTH from the mailing date of this communication (37 CFR 1.515(c)). **EXTENSION OF TIME TO FILE SUCH A PETITION UNDER 37 CFR 1.181 ARE AVAILABLE ONLY BY PETITION TO SUSPEND OR WAIVE THE REGULATIONS UNDER 37 CFR 1.183.**

In due course, a refund under 37 CFR 1.26 ( c ) will be made to requester:

- a) ☐ by Treasury check or,  
b) ☐ by credit to Deposit Account No. \_\_\_\_\_, or  
c) ☐ by credit to a credit card account, unless otherwise notified (35 U.S.C. 303(c)).

Alan Diamond  
Primary Examiner  
Art Unit: 3991

cc:Requester ( if third party requester )

U.S. Patent and Trademark Office  
PTOL-471 (Rev. 08-06)

Office Action in *Ex Parte* Reexamination

Part of Paper No. 20071114

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Application/Control Number: 90/008,826  
Art Unit: 3991

NOV 26 2007

Page 2

VOLPE & KOENIG, P.C.

***Decision on Reexamination Request***

1. A substantial new question of patentability affecting claims 1-5 of United States Patent Number 5,718,805 to Egelhof *et al.* (hereinafter "Egelhof") is raised by the request for *ex parte* reexamination. The request for reexamination is Third Party requested.

***Extension of Time***

2. Extensions of time under 37 CFR 1.136(a) will not be permitted in these proceedings because the provisions of 37 CFR 1.136 apply only to "an applicant" and not to parties in a reexamination proceeding. Additionally, 35 U.S.C. 305 requires that *ex parte* reexamination proceedings "will be conducted with special dispatch" (37 CFR 1.550(a)). Extensions of time in *ex parte* reexamination proceedings are provided for in 37 CFR 1.550(c).

***Substantial New Question of Patentability (SNQ)***

3. The presence or absence of a "substantial new question of patentability" determines whether or not reexamination is ordered.

For a "substantial new question of patentability" to be present, it is only necessary that :

A) the prior art patents and/or printed publications raise a substantial new question of patentability regarding at least one claim, i.e., the teaching of the (prior art)



Application/Control Number: 90/008,826  
Art Unit: 3991

Page 3

patents and printed publications is such that a reasonable examiner would consider the teaching to be important in deciding whether or not the claim is patentable; and

B) the same question of patentability as to the claim has not been decided by the Office in a previous examination of the patent or in a final holding of invalidity by the Federal Courts in a decision on the merits involving the claim.

A SNQ may be based solely on old art where the old art is being presented/viewed in a new light, or in a different way, as compared with its use in the earlier concluded examination(s), in view of a material new argument or interpretation in the request. (MPEP 2242).

#### ***References Relied Upon in the Request***

Schaffrath, P.M. and Green, M.S. "Vertical Forming Machine Gives Symmetrical Sheet Structure." (May 1965) TAPPI 48(5): 50A-52A, (hereinafter "Schaffrath and Green"), newly cited.

"Paper Machine Felts." Ed. Woodside, L.M. (1967), Albany Felt Company, Albany, NY: Chapter IV, pages 17-22, (hereinafter "Verti-Forma '67"), newly cited.

"Paper Machine Felts and Fabrics." Eds. Bergsma, *et al.* (1976) Albany International Corp., Albany, NY: Chapter 4, pages 35-43, (hereinafter "Verti-Forma '76"), newly cited.

Parker, J.D. "The Sheet Forming Process." (1972) TAPPI Fourth Printing: 80-89. (hereinafter "Parker"), newly cited.

Means, GB 1,125,906, old art

Baumann, W. "DUOFORMER-D® - A new Approach to Top Wire Forming." (1988) TAPPI Proceedings – Annual Meeting: pp. 75-80 (hereinafter "Baumann"), newly cited<sup>1</sup>.

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<sup>1</sup> Baumann is newly cited because it does not appear as a cited reference on the face of Egelhof or any of its patented family members. The only application in the Egelhof family chain to go abandoned was Serial No. 07/773,965, which was file-wrapper-continued to Serial No. 08/055,918, which issued as U.S. Patent 5,389,206.

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***Request***

**4. The request indicates the Requester considers that the combination of Schaffrath and Green, admissions in Egelhof, Means, and Baumann raises a substantial new question of patentability with respect to claims 1-5 of Egelhof. The Requester refers collectively to said admissions in Egelhof, Means, and Baumann as "Admitted Prior Art"<sup>2</sup>, and the same terminology is used herein.**

It is agreed that consideration of the combination of Schaffrath and Green and the Admitted Prior Art raises a substantial new question of patentability as to claims 1-5 of Egelhof. Page 11, lines 10-12, and the claim chart at pages 18-63 of the request for reexamination are hereby incorporated by reference for their explanation of the teaching provided in Schaffrath and Green and the Admitted Prior Art that was not present in the prosecution of the application which became the Egelhof patent. There is a substantial likelihood that a reasonable examiner would consider this teaching important in deciding whether or not claims 1-5 of Egelhof were patentable. Accordingly, the combination of Schaffrath and Green and the Admitted Prior Art raises a substantial new question of patentability as to claims 1-5, which question has not been decided in a previous examination of the Egelhof patent.

---

<sup>2</sup> In particular, requester cites col. 1, line 17 to col. 3, line 45 of Egelhof as admitted prior art, and this citation in Egelhof also cites both Means and Baumann. See the paragraph bridging pages 10 and 11 of the request; and, for example, the claim chart on pages 18, 20, and 24, where the Admitted Prior Art refers to cited portions in Egelhof and also refers to Means and Baumann.

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**5. The request indicates the Requester considers that the combination of Verti-Forma '67 and the Admitted Prior Art raises a substantial new question of patentability with respect to claims 1-5 of Egelhof.**

It is agreed that consideration of the combination of Verti-Forma '67 and the Admitted Prior Art raises a substantial new question of patentability as to claims 1-5 of Egelhof. Page 11, lines 13-15, and the claim chart at pages 18-63 of the request for reexamination are hereby incorporated by reference for their explanation of the teaching provided in Verti-Forma '67 and the Admitted Prior Art that was not present in the prosecution of the application which became the Egelhof patent. There is a substantial likelihood that a reasonable examiner would consider this teaching important in deciding whether or not claims 1-5 of Egelhof were patentable. Accordingly, the combination of Verti-Forma '67 and the Admitted Prior Art raises a substantial new question of patentability as to claims 1-5, which question has not been decided in a previous examination of the Egelhof patent.

**6. The request indicates the Requester considers that the combination of Verti-Forma '76 and the Admitted Prior Art raises a substantial new question of patentability with respect to claims 1-5 of Egelhof.**

It is agreed that consideration of the combination of Verti-Forma '76 and the Admitted Prior Art raises a substantial new question of patentability as to claims 1-5 of Egelhof. Page 11, lines 16-18, and the claim chart at pages 18-63 of the request for reexamination are hereby incorporated by reference for their explanation of the teaching

Application/Control Number: 90/008,826  
Art Unit: 3991

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provided in Verti-Forma '76 and the Admitted Prior Art that was not present in the prosecution of the application which became the Egelhof patent. There is a substantial likelihood that a reasonable examiner would consider this teaching important in deciding whether or not claims 1-5 of Egelhof were patentable. Accordingly, the combination of Verti-Forma '76 and the Admitted Prior Art raises a substantial new question of patentability as to claims 1-5, which question has not been decided in a previous examination of the Egelhof patent.

**7. The request indicates the Requester considers that the combination of Parker and the Admitted Prior Art raises a substantial new question of patentability with respect to claims 1-5 of Egelhof.**

It is agreed that consideration of the combination of Parker and the Admitted Prior Art raises a substantial new question of patentability as to claims 1-5 of Egelhof. Page 11, lines 19-20, and the claim chart at pages 18-63 of the request for reexamination are hereby incorporated by reference for their explanation of the teaching provided in Parker and the Admitted Prior Art that was not present in the prosecution of the application which became the Egelhof patent. There is a substantial likelihood that a reasonable examiner would consider this teaching important in deciding whether or not claims 1-5 of Egelhof were patentable. Accordingly, the combination of Parker and the Admitted Prior Art raises a substantial new question of patentability as to claims 1-5, which question has not been decided in a previous examination of the Egelhof patent.

Application/Control Number: 90/008,826  
Art Unit: 3991

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***Duty to Disclose***

8. The patent owner is reminded of the continuing responsibility under 37 CFR 1.565(a) to apprise the Office of any litigation activity, or other prior or concurrent proceeding, involving Patent No. 5,718,805 throughout the course of this reexamination proceeding. The third party requestor is also reminded of the ability to similarly apprise the Office of any such activity or proceeding throughout the course of this reexamination proceeding. See MPEP §§ 2207, 2282 and 2286.

***Correspondence***

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alan Diamond whose telephone number is (571) 272-1338. The examiner can normally be reached on Monday through Friday from 5:30 a.m. to 2:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones can be reached on (571) 272-1535.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 90/008,826  
Art Unit: 3991

Page 8

***Notice Re Patent Owner's Correspondence Address***

Effective May 16, 2007, 37 CFR 1.33(c) has been revised to provide that:

The patent owner's correspondence address for all communications in an *ex parte* reexamination or an *inter partes* reexamination is designated as the correspondence address of the patent.

*Revisions and Technical Corrections Affecting Requirements for Ex Parte and Inter Partes Reexamination, 72 FR 18892 (April 16, 2007)(Final Rule)*

**The correspondence address for any pending reexamination proceeding not having the same correspondence address as that of the patent is, by way of this revision to 37 CFR 1.33(c), automatically changed to that of the patent file as of the effective date.**

This change is effective for any reexamination proceeding which is pending before the Office as of May 16, 2007, including the present reexamination proceeding, and to any reexamination proceeding which is filed after that date.

Parties are to take this change into account when filing papers, and direct communications accordingly.

In the event the patent owner's correspondence address listed in the papers (record) for the present proceeding is different from the correspondence address of the patent, it is strongly encouraged that the patent owner affirmatively file a Notification of Change of Correspondence Address in the reexamination proceeding and/or the patent (depending on which address patent owner desires), to conform the address of the proceeding with that of the patent and to clarify the record as to which address should be used for correspondence.

Telephone Numbers for reexamination inquiries:

Reexamination and Amendment Practice	(571) 272-7703
Central Reexam Unit (CRU)	(571) 272-7705
Reexamination Facsimile Transmission No.	(571) 273-9900

Please mail any communications to:

Attn: Mail Stop "Ex Parte Reexam"  
Central Reexamination Unit  
Commissioner for Patents  
P. O. Box 1450  
Alexandria VA 22313-1450

Application/Control Number: 90/008,826  
Art Unit: 3991

Page 9

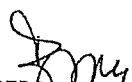
Please FAX any communications to:  
(571) 273-9900  
Central Reexamination Unit

Please hand-deliver any communications to:  
Customer Service Window  
Attn: Central Reexamination Unit  
Randolph Building, Lobby Level  
401 Dulany Street  
Alexandria, VA 22314

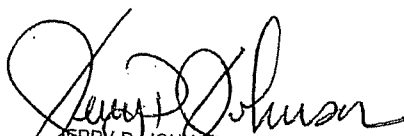
Signed:



Alan Diamond  
Primary Examiner  
Art Unit 3991  
(571) 272-1338



DEBORAH D. JONES  
SPRE-AU 3991  
CENTRAL REEXAMINATION UNIT



JERRY D. JOHNSON  
CRU EXAMINER-AU 3991

Sheet 1 of 1

FORM PTO-1449  U.S. DEPARTMENT OF COMMERCE PATENT AND TRADEMARK OFFICE  INFORMATION DISCLOSURE STATEMENT BY APPLICANT  (Sheet 1 of 2)				ATTY. DOCKET NO.		SERIAL NO. <del>Not yet known</del> 90/008,826 Reexamination of U.S. patent 5,718,805	
				APPLICANT			
				FILING DATE <del>Not yet known</del> 08/24/07		GROUP Central Reexamination Unit 3991	

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U.S. PATENT DOCUMENTS							
EXAMINER INITIAL	DOCUMENT NUMBER	DATE	NAME	CLASS	SUBCLASS	FILING DATE IF APPROPRIATE	

FOREIGN PATENT DOCUMENTS							
DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUBCLASS	TRANSLATION		
					YES	NO	
ADD	GB 1,125,906	10/29/1964	United Kingdom	—	—	—	—

OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, Etc.)		
ADD	1	Schaffrath, P.M. and Marshall, S. G. "Vertical Forming Machine Gives Symmetrical Sheet Structure." (May 1965) Tappi 48(5): 50A-52A.
ADD	2	"Paper Machine Felts." Ed. Woodside, L.M. (1967) Albany Felt Company, Albany, NY: Chapter IV, pages 17-22.
ADD	3	"Paper Machine Felts and Fabrics" Eds. Bergsma, <i>et al.</i> (1976) Albany International Corp., Albany, NY: Chapter 4, pages 35-43.
ADD	4	Parker, J.D. "The Sheet Forming Process." (1972) TAPPI Fourth Printing: 80-89.

EXAMINER 	DATE CONSIDERED 11/15/07
--------------	-----------------------------

EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

EXHIBIT H



Sheet 1 of 1

FORM PTO-1449  U.S. DEPARTMENT OF COMMERCE PATENT AND TRADEMARK OFFICE  INFORMATION DISCLOSURE STATEMENT BY APPLICANT  (Sheet 2 of 2)				ATTY. DOCKET NO.		SERIAL NO. Not yet known 90/008,826 Reexamination of U.S. patent 5,718,805	
				APPLICANT			
				FILING DATE Not yet known 08/24/07		GROUP Central Reexamination Unit 3991	

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U.S. PATENT DOCUMENTS							
EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUBCLASS	FILING DATE IF APPROPRIATE

FOREIGN PATENT DOCUMENTS							
		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUBCLASS	TRANSLATION
							YES   NO

OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, Etc.)		
ADD	5	Baumann, W. "DUOFORMER-D® - A New Approach to Top Wire Forming." (1988) TAPPI Proceedings - Annual Meeting: 75-80.

EXAMINER 	DATE CONSIDERED 11/15/07
--------------	-----------------------------

EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

EXHIBIT H

# Exhibit 8



UNITED STATES PATENT AND TRADEMARK OFFICE

*DTB*

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
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VOLPE & KOENIG, P.C.

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Volpe and Koenig, P.C.  
United Plaza, Suite 1600  
30 South 17<sup>th</sup> Street  
Philadelphia, PA 19103

## EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/008,821.

PATENT NO. 5972168.

ART UNIT 3991.

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified *ex parte* reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the *ex parte* reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).



## UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
 United States Patent and Trademark Office  
 Address: COMMISSIONER FOR PATENTS  
 P.O. Box 1450  
 Alexandria, Virginia 22313-1450  
 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,821	08/24/2007	5972168		2048

2352 7590 11/19/2007

OSTROLENK FABER GERB & SOFFEN  
 1180 AVENUE OF THE AMERICAS  
 NEW YORK, NY 100368403

EXAMINER

ART UNIT PAPER NUMBER

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AM/PM

DATE MAILED: 11/19/2007

NOV 26 2007

VOLPE & KOENIG, P.C.

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Order Granting / Denying Request For Ex Parte Reexamination</b>	<b>Control No.</b>	<b>Patent Under Reexamination</b>	
	90/008,821	5972168	
	<b>Examiner</b>	<b>Art Unit</b>	
	Alan Diamond	3991	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

The request for *ex parte* reexamination filed 24 August 2007 has been considered and a determination has been made. An identification of the claims, the references relied upon, and the rationale supporting the determination are attached.

Attachments: a) ☐ PTO-892, b) ☒ PTO/SB/08, c) ☐ Other: \_\_\_\_\_

1. ☒ The request for *ex parte* reexamination is GRANTED.

RESPONSE TIMES ARE SET AS FOLLOWS:

For Patent Owner's Statement (Optional): TWO MONTHS from the mailing date of this communication (37 CFR 1.530 (b)). **EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).**

For Requester's Reply (optional): TWO MONTHS from the **date of service** of any timely filed Patent Owner's Statement (37 CFR 1.535). **NO EXTENSION OF THIS TIME PERIOD IS PERMITTED.** If Patent Owner does not file a timely statement under 37 CFR 1.530(b), then no reply by requester is permitted.

2. ☐ The request for *ex parte* reexamination is DENIED.

This decision is not appealable (35 U.S.C. 303(c)). Requester may seek review by petition to the Commissioner under 37 CFR 1.181 within ONE MONTH from the mailing date of this communication (37 CFR 1.515(c)). **EXTENSION OF TIME TO FILE SUCH A PETITION UNDER 37 CFR 1.181 ARE AVAILABLE ONLY BY PETITION TO SUSPEND OR WAIVE THE REGULATIONS UNDER 37 CFR 1.183.**

In due course, a refund under 37 CFR 1.26 ( c ) will be made to requester:

- a) ☐ by Treasury check or,  
b) ☐ by credit to Deposit Account No. \_\_\_\_\_, or  
c) ☐ by credit to a credit card account, unless otherwise notified (35 U.S.C. 303(c)).

Alan Diamond  
Primary Examiner  
Art Unit: 3991

cc:Requester ( if third party requester )

Application/Control Number: 90/008,821

Page 2

Art Unit: 3991

***Decision on Reexamination Request***

1. A substantial new question of patentability affecting claims 1-8 of United States Patent Number 5,972,168 to Egelhof *et al.* (hereinafter "Egelhof") is raised by the request for *ex parte* reexamination. The request for reexamination is Third Party requested.

***Extension of Time***

2. Extensions of time under 37 CFR 1.136(a) will not be permitted in these proceedings because the provisions of 37 CFR 1.136 apply only to "an applicant" and not to parties in a reexamination proceeding. Additionally, 35 U.S.C. 305 requires that *ex parte* reexamination proceedings "will be conducted with special dispatch" (37 CFR 1.550(a)). Extensions of time in *ex parte* reexamination proceedings are provided for in 37 CFR 1.550(c).

***Substantial New Question of Patentability (SNQ)***

3. The presence or absence of a "substantial new question of patentability" determines whether or not reexamination is ordered.

For a "substantial new question of patentability" to be present, it is only necessary that :

A) the prior art patents and/or printed publications raise a substantial new question of patentability regarding at least one claim, i.e., the teaching of the (prior art) patents and printed publications is such that a reasonable examiner

Application/Control Number: 90/008,821

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Art Unit: 3991

would consider the teaching to be important in deciding whether or not the claim is patentable; and

B) the same question of patentability as to the claim has not been decided by the Office in a previous examination of the patent or in a final holding of invalidity by the Federal Courts in a decision on the merits involving the claim.

A SNQ may be based solely on old art where the old art is being presented/viewed in a new light, or in a different way, as compared with its use in the earlier concluded examination(s), in view of a material new argument or interpretation in the request. (MPEP 2242).

### ***References Relied Upon in the Request***

Schaffrath, P.M. and Green, M.S. "Vertical Forming Machine Gives Symmetrical Sheet Structure." (May 1965) TAPPI 48(5): 50A-52A, (hereinafter "Schaffrath and Green"), newly cited.

"Paper Machine Felts." Ed. Woodside, L.M. (1967), Albany Felt Company, Albany, NY: Chapter IV, pages 17-22, (hereinafter "Verti-Forma '67"), newly cited.

"Paper Machine Felts and Fabrics." Eds. Bergsma, *et al.* (1976) Albany International Corp., Albany, NY: Chapter 4, pages 35-43, (hereinafter "Verti-Forma '76"), newly cited.

Parker, J.D. "The Sheet Forming Process." (1972) TAPPI Fourth Printing: 80-89. (hereinafter "Parker"), newly cited.

Means, GB 1,125,906, old art

Baumann, W. "DUOFORMER-D® - A new Approach to Top Wire Forming." (1988) TAPPI Proceedings – Annual Meeting: pp. 75-80 (hereinafter "Baumann"), newly cited<sup>1</sup>.

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<sup>1</sup> Baumann is newly cited because it does not appear as a cited reference on the face of Egelhof or any of the patented parents thereof. The only application in the Egelhof family chain to go abandoned was Serial No. 07/773,965, which was file-wrapper-continued to Serial No. 08/055,918, which issued as U.S. Patent 5,389,206.

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***Request***

**4. The request indicates the Requester considers that the combination of Schaffrath and Green, admissions in Egelhof, Means, and Baumann raises a substantial new question of patentability with respect to claims 1-8 of Egelhof. The Requester refers collectively to said admissions in Egelhof, Means, and Baumann as “Admitted Prior Art”<sup>2</sup>, and the same terminology is used herein.**

It is agreed that consideration of the combination of Schaffrath and Green and the Admitted Prior Art raises a substantial new question of patentability as to claims 1-8 of Egelhof. Page 11, lines 8-10, and the claim chart at pages 20-52 of the request for reexamination are hereby incorporated by reference for their explanation of the teaching provided in Schaffrath and Green and the Admitted Prior Art that was not present in the prosecution of the application which became the Egelhof patent. There is a substantial likelihood that a reasonable examiner would consider this teaching important in deciding whether or not claims 1-8 of Egelhof were patentable. Accordingly, the combination of Schaffrath and Green and the Admitted Prior Art raises a substantial new question of patentability as to claims 1-8, which question has not been decided in a previous examination of the Egelhof patent.

---

<sup>2</sup> In particular, requester cites col. 1, line 17 to col. 3, line 45 of Egelhof as admitted prior art, and this citation in Egelhof also cites both Means and Baumann. See the last paragraph on page 10 of the request; and, for example, the claim chart on pages 20-22, where the Admitted Prior Art refers to cited portions in Egelhof and also refers to Means and Baumann.



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**5. The request indicates the Requester considers that the combination of Verti-Forma '67 and the Admitted Prior Art raises a substantial new question of patentability with respect to claims 1-8 of Egelhof.**

It is agreed that consideration of the combination of Verti-Forma '67 and the Admitted Prior Art raises a substantial new question of patentability as to claims 1-8 of Egelhof. Page 11, lines 11-13, and the claim chart at pages 20-52 of the request for reexamination are hereby incorporated by reference for their explanation of the teaching provided in Verti-Forma '67 and the Admitted Prior Art that was not present in the prosecution of the application which became the Egelhof patent. There is a substantial likelihood that a reasonable examiner would consider this teaching important in deciding whether or not claims 1-8 of Egelhof were patentable. Accordingly, the combination of Verti-Forma '67 and the Admitted Prior Art raises a substantial new question of patentability as to claims 1-8, which question has not been decided in a previous examination of the Egelhof patent.

**6. The request indicates the Requester considers that the combination of Verti-Forma '76 and the Admitted Prior Art raises a substantial new question of patentability with respect to claims 1-8 of Egelhof.**

It is agreed that consideration of the combination of Verti-Forma '76 and the Admitted Prior Art raises a substantial new question of patentability as to claims 1-8 of Egelhof. Page 11, lines 14-16, and the claim chart at pages 20-52 of the request for reexamination are hereby incorporated by reference for their

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explanation of the teaching provided in Verti-Forma '76 and the Admitted Prior Art that was not present in the prosecution of the application which became the Egelhof patent. There is a substantial likelihood that a reasonable examiner would consider this teaching important in deciding whether or not claims 1-8 of Egelhof were patentable. Accordingly, the combination of Verti-Forma '76 and the Admitted Prior Art raises a substantial new question of patentability as to claims 1-8, which question has not been decided in a previous examination of the Egelhof patent.

**7. The request indicates the Requester considers that the combination of Parker and the Admitted Prior Art raises a substantial new question of patentability with respect to claims 1-8 of Egelhof.**

It is agreed that consideration of the combination of Parker and the Admitted Prior Art raises a substantial new question of patentability as to claims 1-8 of Egelhof. Page 11, lines 17-18, and the claim chart at pages 20-52 of the request for reexamination are hereby incorporated by reference for their explanation of the teaching provided in Parker and the Admitted Prior Art that was not present in the prosecution of the application which became the Egelhof patent. There is a substantial likelihood that a reasonable examiner would consider this teaching important in deciding whether or not claims 1-8 of Egelhof were patentable. Accordingly, the combination of Parker and the Admitted Prior Art raises a substantial new question of patentability as to claims 1-8, which question has not been decided in a previous examination of the Egelhof patent.

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***Duty to Disclose***

8. The patent owner is reminded of the continuing responsibility under 37 CFR 1.565(a) to apprise the Office of any litigation activity, or other prior or concurrent proceeding, involving Patent No. 5,972,168 throughout the course of this reexamination proceeding. The third party requestor is also reminded of the ability to similarly apprise the Office of any such activity or proceeding throughout the course of this reexamination proceeding. See MPEP §§ 2207, 2282 and 2286.

***Correspondence***

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alan Diamond whose telephone number is (571) 272-1338. The examiner can normally be reached on Monday through Friday from 5:30 a.m. to 2:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones can be reached on (571) 272-1535.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR

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system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

***Notice Re Patent Owner's Correspondence Address***

Effective May 16, 2007, 37 CFR 1.33(c) has been revised to provide that:

The patent owner's correspondence address for all communications in an *ex parte* reexamination or an *inter partes* reexamination is designated as the correspondence address of the patent.

*Revisions and Technical Corrections Affecting Requirements for Ex Parte and Inter Partes Reexamination, 72 FR 18892 (April 16, 2007)(Final Rule)*

**The correspondence address for any pending reexamination proceeding not having the same correspondence address as that of the patent is, by way of this revision to 37 CFR 1.33(c), automatically changed to that of the patent file as of the effective date.**

This change is effective for any reexamination proceeding which is pending before the Office as of May 16, 2007, including the present reexamination proceeding, and to any reexamination proceeding which is filed after that date.

Parties are to take this change into account when filing papers, and direct communications accordingly.

In the event the patent owner's correspondence address listed in the papers (record) for the present proceeding is different from the correspondence address of the patent, it is strongly encouraged that the patent owner affirmatively file a Notification of Change of Correspondence Address in the reexamination proceeding and/or the patent (depending on which address patent owner desires), to conform the address of the proceeding with that of the patent and to clarify the record as to which address should be used for correspondence.

Telephone Numbers for reexamination inquiries:

Reexamination and Amendment Practice	(571) 272-7703
Central Reexam Unit (CRU)	(571) 272-7705
Reexamination Facsimile Transmission No.	(571) 273-9900

Application/Control Number: 90/008,821

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Please mail any communications to:

Attn: Mail Stop "Ex Parte Reexam"  
Central Reexamination Unit  
Commissioner for Patents  
P. O. Box 1450  
Alexandria VA 22313-1450

Please FAX any communications to:

(571) 273-9900  
Central Reexamination Unit

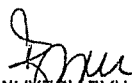
Please hand-deliver any communications to:

Customer Service Window  
Attn: Central Reexamination Unit  
Randolph Building, Lobby Level  
401 Dulany Street  
Alexandria, VA 22314

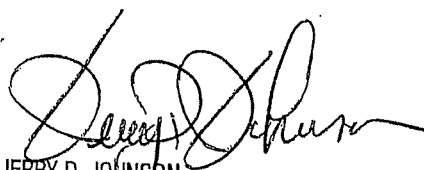
Signed:



Alan Diamond  
Primary Examiner  
Art Unit 3991  
(571) 272-1338



CENTRAL REEXAMINATION UNIT  
SPRE-AU 3991  
DEBORAH D. JONES  
SPRE-AU 3991  
CENTRAL REEXAMINATION UNIT



JERRY D. JOHNSON  
CRU EXAMINER-AU 3991

Sheet 1 of 1

Sheet 1 of 1

FORM PTO-1449

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

INFORMATION DISCLOSURE  
STATEMENT BY APPLICANT

(Page 1 of 2)

ATTY. DOCKET NO.

SERIAL NO.  
~~Not yet known~~ 90/008,821

Reexamination of U.S. patent  
5,972,386

APPLICANT

NOV 26 2007

VOLPE GROUP  
Central Reexamination Unit, PC.

FILING DATE  
~~Not yet known~~  
08/24/07

3991

U.S. PATENT DOCUMENTS							
EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUBCLASS	FILING DATE IF APPROPRIATE

FOREIGN PATENT DOCUMENTS								
		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUBCLASS	TRANSLATION	
							YES	NO
ADD		GB 1,125,906	10/29/1964	United Kingdom				

OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, Etc.)		
ADD	1	Schaffrath, P.M. and Marshall, S. G. "Vertical Forming Machine Gives Symmetrical Sheet Structure." (May 1965) Tappi 48(5): 50A-52A.
ADD	2	"Paper Machine Felts." Ed. Woodside, L.M. (1967) Albany Felt Company, Albany, NY: Chapter IV, pages 17-22.
ADD	3	"Paper Machine Felts and Fabrics" Eds. Bergsma, <i>et al.</i> (1976) Albany International Corp., Albany, NY: Chapter 4, pages 35-43.
ADD	4	Parker, J.D. "The Sheet Forming Process." (1972) TAPPI Fourth Printing: 80-89.

EXAMINER <i>al</i>	DATE CONSIDERED 11/13/07
-----------------------	-----------------------------

EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

EXHIBIT H



Sheet 1 of 1

FORM PTO-1449  U.S. DEPARTMENT OF COMMERCE PATENT AND TRADEMARK OFFICE  INFORMATION DISCLOSURE STATEMENT BY APPLICANT  (Page 2 of 2)				ATTY. DOCKET NO.		SERIAL NO. Not yet known 90/008,821	
				APPLICANT			
				FILING DATE Not yet known 08/24/07		Reexamination of U.S. patent 5,972,168 NOV 26 2007 VERGUP Central Reexamination Unit 3991 RECEIVED AMP/PA NOV 26 2007 VERGUP & ASSOCIATES, P.C.	
U.S. PATENT DOCUMENTS							
EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUBCLASS	FILING DATE IF APPROPRIATE
FOREIGN PATENT DOCUMENTS							
		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUBCLASS	TRANSLATION YES NO
OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, Etc.)							
ADD	5	Baumann, W. "DUOFORMER-D® - A New Approach to Top Wire Forming." (1988) TAPPI Proceedings – Annual Meeting: 75-80.					

EXAMINER 	DATE CONSIDERED 11/13/07
---	-----------------------------

EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

EXHIBIT H



# Exhibit 9



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JAN 28 2008

VOLPE & KOENIG, P.C.

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
www.uspto.gov

DO NOT USE IN PALM PRINTER

(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Volpe and Koenig, P.C.  
United Plaza, Suite 1600  
30 South 17<sup>th</sup> Street  
Philadelphia, PA 19103

## EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/008,924.

PATENT NO. 5389206.

ART UNIT 3991.

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified *ex parte* reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the *ex parte* reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).



## UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
 United States Patent and Trademark Office  
 Address: COMMISSIONER FOR PATENTS  
 P.O. Box 1450  
 Alexandria, Virginia 22313-1450  
 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,924	11/16/2007	5389206		6128

7590

01/23/2008

Martin Pfeffer  
 OSTROLENK, FABER, GERB & SOFFEN  
 1180 Avenue of the Americas  
 New York, NY 10036-8403

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JAN 28 2008

VOLPE &amp; KOENIG, P.C.

EXAMINER

ART UNIT

PAPER NUMBER

DATE MAILED: 01/23/2008

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Order Granting / Denying Request For Ex Parte Reexamination</b>	Control No.	Patent Under Reexamination	
	90/008,924	5389206	
	Examiner	Art Unit	
	Alan Diamond	3991	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

The request for *ex parte* reexamination filed 16 November 2007 has been considered and a determination has been made. An identification of the claims, the references relied upon, and the rationale supporting the determination are attached.

Attachments: a) ☐ PTO-892, b) ☒ PTO/SB/08, c) ☐ Other: \_\_\_\_\_

1. ☒ The request for *ex parte* reexamination is GRANTED.

RESPONSE TIMES ARE SET AS FOLLOWS:

For Patent Owner's Statement (Optional): TWO MONTHS from the mailing date of this communication (37 CFR 1.530 (b)). **EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).**

For Requester's Reply (optional): TWO MONTHS from the **date of service** of any timely filed Patent Owner's Statement (37 CFR 1.535). **NO EXTENSION OF THIS TIME PERIOD IS PERMITTED.** If Patent Owner does not file a timely statement under 37 CFR 1.530(b), then no reply by requester is permitted.

2. ☐ The request for *ex parte* reexamination is DENIED.

This decision is not appealable (35 U.S.C. 303(c)). Requester may seek review by petition to the Commissioner under 37 CFR 1.181 within ONE MONTH from the mailing date of this communication (37 CFR 1.515(c)). **EXTENSION OF TIME TO FILE SUCH A PETITION UNDER 37 CFR 1.181 ARE AVAILABLE ONLY BY PETITION TO SUSPEND OR WAIVE THE REGULATIONS UNDER 37 CFR 1.183.**

In due course, a refund under 37 CFR 1.26 (c) will be made to requester:

- a) ☐ by Treasury check or,  
b) ☐ by credit to Deposit Account No. \_\_\_\_\_, or  
c) ☐ by credit to a credit card account, unless otherwise notified (35 U.S.C. 303(c)).

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\_\_\_\_\_  
AM/PM

JAN 28 2008

VOLPE & KOENIG, P.C.

Alan Diamond  
Primary Examiner  
Art Unit: 3991

cc:Requester (if third party requester)

Application/Control Number:  
90/008,924  
Art Unit: 3991

Page 2 RECEIVED  
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JAN 28 2008

VOLPE & KOENIG, P.C.

***Decision on Reexamination Request***

1. A substantial new question of patentability affecting claims 1-18 of United States Patent Number 5,389,206 to Buck *et al.* (hereinafter "Buck") is raised by the request for *ex parte* reexamination. The request for reexamination is Third Party requested.

***Extension of Time***

2. Extensions of time under 37 CFR 1.136(a) will not be permitted in these proceedings because the provisions of 37 CFR 1.136 apply only to "an applicant" and not to parties in a reexamination proceeding. Additionally, 35 U.S.C. 305 requires that *ex parte* reexamination proceedings "will be conducted with special dispatch" (37 CFR 1.550(a)). Extensions of time in *ex parte* reexamination proceedings are provided for in 37 CFR 1.550(c).

***Substantial New Question of Patentability (SNQ)***

3. The presence or absence of a "substantial new question of patentability" determines whether or not reexamination is ordered.

For a "substantial new question of patentability" to be present, it is only necessary that :

A) the prior art patents and/or printed publications raise a substantial new question of patentability regarding at least one claim, i.e., the teaching of the (prior art) patents and printed publications is such that a reasonable examiner would consider the teaching to be important in deciding whether or not the claim is patentable; and

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B) the same question of patentability as to the claim has not been decided by the Office in a previous examination of the patent or in a final holding of invalidity by the Federal Courts in a decision on the merits involving the claim.

A SNQ may be based solely on old art where the old art is being presented/viewed in a new light, or in a different way, as compared with its use in the earlier concluded examination(s), in view of a material new argument or interpretation in the request. (MPEP 2242).

***References Relied Upon in the Request***

Schaffrath, P.M. and Green, M.S. "Vertical Forming Machine Gives Symmetrical Sheet Structure." (May 1965) TAPPI 48(5): 50A-52A, (hereinafter "Schaffrath and Green"), newly cited.

"Paper Machine Felts." Ed. Woodside, L.M. (1967), Albany Felt Company, Albany, NY: Chapter IV, pages 17-22, (hereinafter "Verti-Forma '67"), newly cited.

"Paper Machine Felts and Fabrics." Eds. Bergsma, *et al.* (1976) Albany International Corp., Albany, NY: Chapter 4, pages 35-43, (hereinafter "Verti-Forma '76"), newly cited.

Parker, J.D. "The Sheet Forming Process." (1972) TAPPI Fourth Printing: 80-89. (hereinafter "Parker"), newly cited.

Norman, B. "Principles of Twin-Wire Forming," Svensk Papperstidning, 8(11); pages 330-336, (1979), newly cited.

Baxter, Jr *et al.*, U.S. Patent 3,215,594 (hereinafter "Baxter"), newly cited.

Means, GB 1,125,906, old art.

Baumann, W. "DUOFORMER-D® - A new Approach to Top Wire Forming." (1988) TAPPI Proceedings - Annual Meeting: pp. 75-80 (hereinafter "Baumann"), newly cited.

Bubik, DE 3138133 A1, old art.

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***Request***

4. The request indicates the Requester considers that the combination of Schaffrath and Green and admissions in Buck, Means, Baumann and Bubik raises a substantial new question of patentability with respect to claims 1, 3, 7, 8, 10, 11, 13, 16 and 18 of Buck. The Requester refers collectively to said admissions in Buck, Means, Baumann and Bubik as "Admitted Prior Art"<sup>1</sup>, and the same terminology is used herein.

It is agreed that consideration of the combination of Schaffrath and Green and the Admitted Prior Art raises a substantial new question of patentability as to claims 1, 3, 7, 8, 10, 11, 13, 16 and 18 of Buck. The claim chart at pages 32-42 and 44-51 of the request for reexamination are hereby incorporated by reference for their explanation of the teaching provided in Schaffrath and Green and the Admitted Prior Art that was not present in the prosecution of the application which became the Buck patent. There is a substantial likelihood that a reasonable examiner would consider this teaching important in deciding whether or not claims 1, 3, 7, 8, 10, 11, 13, 16 and 18 of Buck were patentable. Accordingly, the combination of Schaffrath and Green and the Admitted Prior Art raises a substantial new question of patentability as to claims 1, 3, 7, 8, 10, 11, 13, 16 and 18, which question has not been decided in a previous examination of the Buck patent.

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**5. The request indicates the Requester considers that the combination of Schaffrath and Green, Norman and the Admitted Prior Art raises a substantial new question of patentability with respect to claims 2, 9, 12, 14, 15 and 17 of Buck.**

It is agreed that consideration of the combination of Schaffrath and Green, Norman and the Admitted Prior Art raises a substantial new question of patentability as to claims 2, 9, 12, 14, 15 and 17 of Buck. The claim chart at pages 42 and 45-50 of the request for reexamination are hereby incorporated by reference for their explanation of the teaching provided in Schaffrath and Green, Norman and the Admitted Prior Art that was not present in the prosecution of the application which became the Buck patent. There is a substantial likelihood that a reasonable examiner would consider this teaching important in deciding whether or not claims 2, 9, 12, 14, 15 and 17 of Buck were patentable. Accordingly, the combination of Schaffrath and Green, Norman and the Admitted Prior Art raises a substantial new question of patentability as to claims 2, 9, 12, 14, 15 and 17, which question has not been decided in a previous examination of the Buck patent.

**6. The request indicates the Requester considers that the combination of Schaffrath and Green, Baxter and the Admitted Prior Art raises a substantial new question of patentability with respect to claims 4-6 of Buck.**

---

<sup>1</sup> In particular, requester cites col. 1, line 8 through col. 3, line 61 of Buck as admitted prior art, and this citation in Buck also cites Means, Baumann and Bubik. See the paragraph bridging pages 9 and 10 of the request; and, for example, the claim chart on pages 32-37, where the Admitted Prior Art refers to cited portions in Buck and also refers to Means, Baumann and Bubik.



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It is agreed that consideration of the combination of Schaffrath and Green, Baxter and the Admitted Prior Art raises a substantial new question of patentability as to claims 4-6 of Buck. The claim chart at pages 43-44 of the request for reexamination are hereby incorporated by reference for their explanation of the teaching provided in Schaffrath and Green, Baxter and the Admitted Prior Art that was not present in the prosecution of the application which became the Buck patent. There is a substantial likelihood that a reasonable examiner would consider this teaching important in deciding whether or not claims 4-6 of Buck were patentable. Accordingly, the combination of Schaffrath and Green, Baxter and the Admitted Prior Art raises a substantial new question of patentability as to claims 4-6, which question has not been decided in a previous examination of the Buck patent.

**7. The request indicates the Requester considers that the combination of Verti-Forma '67 and the Admitted Prior Art raises a substantial new question of patentability with respect to claims 1, 3, 7, 8, 10, 11, 13, 16 and 18 of Buck.**

It is agreed that consideration of the combination of Verti-Forma '67 and the Admitted Prior Art raises a substantial new question of patentability as to claims 1, 3, 7, 8, 10, 11, 13, 16 and 18 of Buck. The claim chart at pages 51-70 of the request for reexamination are hereby incorporated by reference for their explanation of the teaching provided in Verti-Forma '67 and the Admitted Prior Art that was not present in the prosecution of the application which became the Buck patent. There is a substantial likelihood that a reasonable examiner would consider this teaching important in deciding

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90/008,924  
Art Unit: 3991

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whether or not claims 1, 3, 7, 8, 10, 11, 13, 16 and 18 of Buck were patentable.

Accordingly, the combination of Verti-Forma '67 and the Admitted Prior Art raises a substantial new question of patentability as to claims 1, 3, 7, 8, 10, 11, 13, 16 and 18, which question has not been decided in a previous examination of the Buck patent.

**8. The request indicates the Requester considers that the combination of Verti-Forma '67, Norman and the Admitted Prior Art raises a substantial new question of patentability with respect to claims 2, 9, 12, 14, 15 and 17 of Buck.**

It is agreed that consideration of the combination of Verti-Forma '67, Norman and the Admitted Prior Art raises a substantial new question of patentability as to claims 2, 9, 12, 14, 15 and 17 of Buck. The claim chart at pages 61 and 65-69 of the request for reexamination are hereby incorporated by reference for their explanation of the teaching provided in Verti-Forma '67, Norman and the Admitted Prior Art that was not present in the prosecution of the application which became the Buck patent. There is a substantial likelihood that a reasonable examiner would consider this teaching important in deciding whether or not claims 2, 9, 12, 14, 15 and 17 of Buck were patentable. Accordingly, the combination of Verti-Forma '67, Norman and the Admitted Prior Art raises a substantial new question of patentability as to claims 2, 9, 12, 14, 15 and 17, which question has not been decided in a previous examination of the Buck patent.

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**9. The request indicates the Requester considers that the combination of Verti-Forma '67, Baxter and the Admitted Prior Art raises a substantial new question of patentability with respect to claims 4-6 of Buck.**

It is agreed that consideration of the combination of Verti-Forma '67, Baxter and the Admitted Prior Art raises a substantial new question of patentability as to claims 4-6 of Buck. The claim chart at pages 62-63 of the request for reexamination are hereby incorporated by reference for their explanation of the teaching provided in Verti-Forma '67, Baxter and the Admitted Prior Art that was not present in the prosecution of the application which became the Buck patent. There is a substantial likelihood that a reasonable examiner would consider this teaching important in deciding whether or not claims 4-6 of Buck were patentable. Accordingly, the combination of Verti-Forma '67, Baxter and the Admitted Prior Art raises a substantial new question of patentability as to claims 4-6, which question has not been decided in a previous examination of the Buck patent.

**10. The request indicates the Requester considers that the combination of Verti-Forma '76 and the Admitted Prior Art raises a substantial new question of patentability with respect to claims 1, 3, 7, 8, 10, 11, 13, 16 and 18 of Buck.**

It is agreed that consideration of the combination of Verti-Forma '76 and the Admitted Prior Art raises a substantial new question of patentability as to claims 1, 3, 7, 8, 10, 11, 13, 16 and 18 of Buck. The claim chart at pages 70-81, 83-86 and 88-89 of the request for reexamination are hereby incorporated by reference for their explanation

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of the teaching provided in Verti-Forma '76 and the Admitted Prior Art that was not present in the prosecution of the application which became the Buck patent. There is a substantial likelihood that a reasonable examiner would consider this teaching important in deciding whether or not claims 1, 3, 7, 8, 10, 11, 13, 16 and 18 of Buck were patentable. Accordingly, the combination of Verti-Forma '76 and the Admitted Prior Art raises a substantial new question of patentability as to claims 1, 3, 7, 8, 10, 11, 13, 16 and 18, which question has not been decided in a previous examination of the Buck patent.

**11. The request indicates the Requester considers that the combination of Verti-Forma '76, Norman and the Admitted Prior Art raises a substantial new question of patentability with respect to claims 2, 9, 12, 14, 15 and 17 of Buck.**

It is agreed that consideration of the combination of Verti-Forma '76, Norman and the Admitted Prior Art raises a substantial new question of patentability as to claims 2, 9, 12, 14, 15 and 17 of Buck. The claim chart at pages 80, 84, 86, 87 and 89 of the request for reexamination are hereby incorporated by reference for their explanation of the teaching provided in Verti-Forma '76, Norman and the Admitted Prior Art that was not present in the prosecution of the application which became the Buck patent. There is a substantial likelihood that a reasonable examiner would consider this teaching important in deciding whether or not claims 2, 9, 12, 14, 15 and 17 of Buck were patentable. Accordingly, the combination of Verti-Forma '76, Norman and the Admitted Prior Art raises a substantial new question of patentability as to claims 2, 9, 12, 14, 15

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and 17, which question has not been decided in a previous examination of the Buck patent.

**12. The request indicates the Requester considers that the combination of Verti-Forma '76, Baxter and the Admitted Prior Art raises a substantial new question of patentability with respect to claims 4-6 of Buck.**

It is agreed that consideration of the combination of Verti-Forma '76, Baxter and the Admitted Prior Art raises a substantial new question of patentability as to claims 4-6 of Buck. The claim chart at pages 81 and 82 of the request for reexamination are hereby incorporated by reference for their explanation of the teaching provided in Verti-Forma '76, Baxter and the Admitted Prior Art that was not present in the prosecution of the application which became the Buck patent. There is a substantial likelihood that a reasonable examiner would consider this teaching important in deciding whether or not claims 4-6 of Buck were patentable. Accordingly, the combination of Verti-Forma '76, Baxter and the Admitted Prior Art raises a substantial new question of patentability as to claims 4-6, which question has not been decided in a previous examination of the Buck patent.

**13. The request indicates the Requester considers that the combination of Parker and the Admitted Prior Art raises a substantial new question of patentability with respect to claims 1, 3, 7, 8, 10, 11, 13, 16 and 18 of Buck.**

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90/008,924  
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It is agreed that consideration of the combination of Parker and the Admitted Prior Art raises a substantial new question of patentability as to claims 1, 3, 7, 8, 10, 11, 13, 16 and 18 of Buck. The claim chart at pages 90-100 and 102-108 of the request for reexamination are hereby incorporated by reference for their explanation of the teaching provided in Parker and the Admitted Prior Art that was not present in the prosecution of the application which became the Buck patent. There is a substantial likelihood that a reasonable examiner would consider this teaching important in deciding whether or not claims 1, 3, 7, 8, 10, 11, 13, 16 and 18 of Buck were patentable. Accordingly, the combination of Parker and the Admitted Prior Art raises a substantial new question of patentability as to claims 1, 3, 7, 8, 10, 11, 13, 16 and 18, which question has not been decided in a previous examination of the Buck patent.

**14. The request indicates the Requester considers that the combination of Parker, Norman and the Admitted Prior Art raises a substantial new question of patentability with respect to claims 2, 9, 12, 14, 15 and 17 of Buck.**

It is agreed that consideration of the combination of Parker, Norman and the Admitted Prior Art raises a substantial new question of patentability as to claims 2, 9, 12, 14, 15 and 17 of Buck. The claim chart at pages 99, 100 and 103-107 of the request for reexamination are hereby incorporated by reference for their explanation of the teaching provided in Parker, Norman and the Admitted Prior Art that was not present in the prosecution of the application which became the Buck patent. There is a substantial likelihood that a reasonable examiner would consider this teaching important

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Page 12

in deciding whether or not claims 2, 9, 12, 14, 15 and 17 of Buck were patentable. Accordingly, the combination of Parker, Norman and the Admitted Prior Art raises a substantial new question of patentability as to claims 2, 9, 12, 14, 15 and 17, which question has not been decided in a previous examination of the Buck patent.

**15. The request indicates the Requester considers that the combination of Parker, Baxter and the Admitted Prior Art raises a substantial new question of patentability with respect to claims 4-6 of Buck.**

It is agreed that consideration of the combination of Parker, Baxter and the Admitted Prior Art raises a substantial new question of patentability as to claims 4-6 of Buck. The claim chart at pages 100-101 of the request for reexamination are hereby incorporated by reference for their explanation of the teaching provided in Parker, Baxter and the Admitted Prior Art that was not present in the prosecution of the application which became the Buck patent. There is a substantial likelihood that a reasonable examiner would consider this teaching important in deciding whether or not claims 4-6 of Buck were patentable. Accordingly, the combination of Parker, Baxter and the Admitted Prior Art raises a substantial new question of patentability as to claims 4-6, which question has not been decided in a previous examination of the Buck patent.

***Duty to Disclose***

16. The patent owner is reminded of the continuing responsibility under 37 CFR 1.565(a) to apprise the Office of any litigation activity, or other prior or concurrent

Application/Control Number:  
90/008,924  
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proceeding, involving Patent No. 5,389,206 throughout the course of this reexamination proceeding. The third party requestor is also reminded of the ability to similarly apprise the Office of any such activity or proceeding throughout the course of this reexamination proceeding. See MPEP §§ 2207, 2282 and 2286.

### ***Correspondence***

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alan Diamond whose telephone number is (571) 272-1338. The examiner can normally be reached on Monday through Friday from 5:30 a.m. to 2:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones can be reached on (571) 272-1535.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

### ***Notice Re Patent Owner's Correspondence Address***

Effective May 16, 2007, 37 CFR 1.33(c) has been revised to provide that:



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90/008,924  
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Page 14

The patent owner's correspondence address for all communications in an *ex parte* reexamination or an *inter partes* reexamination is designated as the correspondence address of the patent.

*Revisions and Technical Corrections Affecting Requirements for Ex Parte and Inter Partes Reexamination, 72 FR 18892 (April 16, 2007)(Final Rule)*

**The correspondence address for any pending reexamination proceeding not having the same correspondence address as that of the patent is, by way of this revision to 37 CFR 1.33(c), automatically changed to that of the patent file as of the effective date.**

This change is effective for any reexamination proceeding which is pending before the Office as of May 16, 2007, including the present reexamination proceeding, and to any reexamination proceeding which is filed after that date.

Parties are to take this change into account when filing papers, and direct communications accordingly

In the event the patent owner's correspondence address listed in the papers (record) for the present proceeding is different from the correspondence address of the patent, it is strongly encouraged that the patent owner affirmatively file a Notification of Change of Correspondence Address in the reexamination proceeding and/or the patent (depending on which address patent owner desires), to conform the address of the proceeding with that of the patent and to clarify the record as to which address should be used for correspondence.

Telephone Numbers for reexamination inquiries:

Reexamination and Amendment Practice	(571) 272-7703
Central Reexam Unit (CRU)	(571) 272-7705
Reexamination Facsimile Transmission No.	(571) 273-9900

Please mail any communications to:

Attn: Mail Stop "Ex Parte Reexam"  
Central Reexamination Unit  
Commissioner for Patents  
P. O. Box 1450  
Alexandria VA 22313-1450

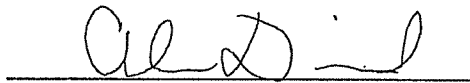
Application/Control Number:  
90/008,924  
Art Unit: 3991

Page 15


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(571) 273-9900  
Central Reexamination Unit

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Customer Service Window  
Attn: Central Reexamination Unit  
Randolph Building, Lobby Level  
401 Dulany Street  
Alexandria, VA 22314

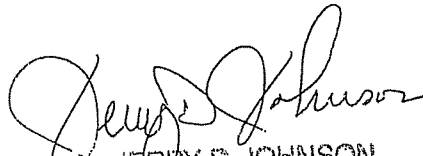
Signed:



Alan Diamond  
Primary Examiner  
Art Unit 3991  
(571) 272-1338



DEBORAH D. JONES  
CRU SPE-AU 3991



JERRY D. JOHNSON  
PRIMARY EXAMINER  
CRU - AU 3991

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JAN 28 2008

Sheet 1 of 2

FORM PTO-1449  U.S. DEPARTMENT OF COMMERCE PATENT AND TRADEMARK OFFICE  INFORMATION DISCLOSURE STATEMENT BY APPLICANT  (Sheet 1 of 2)				VOLPE & KOENIG, P.C. ATTY. DOCKET NO.		SERIAL NO. Not yet known Reexamination of U.S. patent 5,389,206	
				Bück <i>et al.</i>			
				FILING DATE Not yet known		GROUP Central Reexamination Unit	
U.S. PATENT DOCUMENTS							
EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUBCLASS	FILING DATE IF APPROPRIATE
/AD/		U.S. 3,215,594	11/02/1965	Baxter <i>et al.</i>	—	—	—
FOREIGN PATENT DOCUMENTS							
		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUBCLASS	TRANSLATION YES NO
/AD/		GB 1,125,906	10/29/1964	United Kingdom	—	—	— —
/AD/		DE 31 38 133	09/25/1981	Federal Republic of Germany	—	—	✓ —
OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, Etc.)							
/AD/	1	Schaffrath, P.M. and Green, M.S. "Vertical Forming Machine Gives Symmetrical Sheet Structure." (May 1965) TAPPI 48(5): 50A-52A.					
/AD/	2	"Paper Machine Felts." Ed. Woodside, L.M. (1967) Albany Felt Company, Albany, NY: Chapter IV, pages 17-22.					
/AD/	3	"Paper Machine Felts and Fabrics" Eds. Bergsma, <i>et al.</i> (1976) Albany International Corp., Albany, NY: Chapter 4, pages 35-43.					
/AD/	4	Parker, J.D. "The Sheet Forming Process." (1972) TAPPI Fourth Printing: 80-89.					
EXAMINER /Alan Diamond/				DATE CONSIDERED 01/16/2008			

EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

EXHIBIT M

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JAN 28 2008

VOLPE &amp; KOENIG, P.C. Sheet 2 of 2

FORM PTO-1449 U.S. DEPARTMENT OF COMMERCE PATENT AND TRADEMARK OFFICE INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Sheet 2 of 2)				ATTY. DOCKET NO.		SERIAL NO. Not yet known Reexamination of U.S. patent 5,389,206	
				Bück <i>et al.</i>			
				FILING DATE Not yet known		GROUP Central Reexamination Unit	
U.S. PATENT DOCUMENTS							
EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUBCLASS	FILING DATE IF APPROPRIATE
FOREIGN PATENT DOCUMENTS							
		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUBCLASS	TRANSLATION
							YES NO
OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, Etc.)							
/AD/	5	Baumann, W. "DUOFORMER-D® - A New Approach to Top Wire Forming." (1988) TAPPI Proceedings - Annual Meeting: 75-80.					
/AD/		Norman, B. "Principles of twin-wire forming." Svensk Papperstidning (1979) 82 (11), 330-336.					

/Alan Diamond/ EXAMINER	01/16/2008 DATE CONSIDERED
-------------------------	----------------------------

EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

EXHIBIT M

# **Exhibit 10**



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
www.uspto.gov

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DEC 26 2007

VOLPE & KOENIG, P.C.

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Volpe and Koenig, P.C.  
United Plaza, Suite 1600  
30 South 17<sup>th</sup> Street  
Philadelphia, PA 19103

## EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/008,932.

PATENT NO. 5,500,091.

ART UNIT 3991.

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified *ex parte* reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the *ex parte* reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).

<b>Order Granting / Denying Request For Ex Parte Reexamination</b>	<b>Control No.</b>	<b>Patent Under Reexamination</b>	
	90/008,932	5,500,091	
	<b>Examiner</b>	<b>Art Unit</b>	
	Alan Diamond	3991	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

The request for *ex parte* reexamination filed 16 November 2007 has been considered and a determination has been made. An identification of the claims, the references relied upon, and the rationale supporting the determination are attached.

Attachments: a) ☐ PTO-892, b) ☒ PTO/SB/08, c) ☐ Other: \_\_\_\_\_

1. ☒ The request for *ex parte* reexamination is GRANTED.

RESPONSE TIMES ARE SET AS FOLLOWS:

For Patent Owner's Statement (Optional): TWO MONTHS from the mailing date of this communication (37 CFR 1.530 (b)). **EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).**

For Requester's Reply (optional): TWO MONTHS from the **date of service** of any timely filed Patent Owner's Statement (37 CFR 1.535). **NO EXTENSION OF THIS TIME PERIOD IS PERMITTED.** If Patent Owner does not file a timely statement under 37 CFR 1.530(b), then no reply by requester is permitted.

2. ☐ The request for *ex parte* reexamination is DENIED.

This decision is not appealable (35 U.S.C. 303(c)). Requester may seek review by petition to the Commissioner under 37 CFR 1.181 within ONE MONTH from the mailing date of this communication (37 CFR 1.515(c)). **EXTENSION OF TIME TO FILE SUCH A PETITION UNDER 37 CFR 1.181 ARE AVAILABLE ONLY BY PETITION TO SUSPEND OR WAIVE THE REGULATIONS UNDER 37 CFR 1.183.**

In due course, a refund under 37 CFR 1.26 ( c ) will be made to requester:

- a) ☐ by Treasury check or,  
b) ☐ by credit to Deposit Account No. \_\_\_\_\_, or  
c) ☐ by credit to a credit card account, unless otherwise notified (35 U.S.C. 303(c)).

Alan Diamond  
Primary Examiner  
Art Unit: 3991

cc:Requester ( if third party requester )

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90/008,932  
Art Unit: 3991

Page 2

***Decision on Reexamination Request***

1. A substantial new question of patentability affecting claims 1 and 2 of United States Patent Number 5,500,091 to Buck *et al.* (hereinafter "Buck") is raised by the request for *ex parte* reexamination. The request for reexamination is Third Party requested.

***Extension of Time***

2. Extensions of time under 37 CFR 1.136(a) will not be permitted in these proceedings because the provisions of 37 CFR 1.136 apply only to "an applicant" and not to parties in a reexamination proceeding. Additionally, 35 U.S.C. 305 requires that *ex parte* reexamination proceedings "will be conducted with special dispatch" (37 CFR 1.550(a)). Extensions of time in *ex parte* reexamination proceedings are provided for in 37 CFR 1.550(c).

***Substantial New Question of Patentability (SNQ)***

3. The presence or absence of a "substantial new question of patentability" determines whether or not reexamination is ordered.

For a "substantial new question of patentability" to be present, it is only necessary that :

A) the prior art patents and/or printed publications raise a substantial new question of patentability regarding at least one claim, i.e., the teaching of the (prior art)



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90/008,932  
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patents and printed publications is such that a reasonable examiner would consider the teaching to be important in deciding whether or not the claim is patentable; and

B) the same question of patentability as to the claim has not been decided by the Office in a previous examination of the patent or in a final holding of invalidity by the Federal Courts in a decision on the merits involving the claim.

A SNQ may be based solely on old art where the old art is being presented/viewed in a new light, or in a different way, as compared with its use in the earlier concluded examination(s), in view of a material new argument or interpretation in the request. (MPEP 2242).

#### ***References Relied Upon in the Request***

Schaffrath, P.M. and Green, M.S. "Vertical Forming Machine Gives Symmetrical Sheet Structure." (May 1965) TAPPI 48(5): 50A-52A, (hereinafter "Schaffrath and Green"), newly cited.

"Paper Machine Felts." Ed. Woodside, L.M. (1967), Albany Felt Company, Albany, NY: Chapter IV, pages 17-22, (hereinafter "Verti-Forma '67"), newly cited.

"Paper Machine Felts and Fabrics." Eds. Bergsma, *et al.* (1976) Albany International Corp., Albany, NY: Chapter 4, pages 35-43, (hereinafter "Verti-Forma '76"), newly cited.

Parker, J.D. "The Sheet Forming Process." (1972) TAPPI Fourth Printing: 80-89. (hereinafter "Parker"), newly cited.

Means, GB 1,125,906, old art.

Baumann, W. "DUOFORMER-D® - A new Approach to Top Wire Forming." (1988) TAPPI Proceedings – Annual Meeting: pp. 75-80 (hereinafter "Baumann"), newly cited.

Bubik, DE 3138133 A1, old art.

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***Request***

**4. The request indicates the Requester considers that the combination of Schaffrath and Green, admissions in Buck, Means, Baumann and Bubik raises a substantial new question of patentability with respect to claims 1 and 2 of Buck. The Requester refers collectively to said admissions in Buck, Means, Baumann and Bubik as "Admitted Prior Art"<sup>1</sup>, and the same terminology is used herein.**

It is agreed that consideration of the combination of Schaffrath and Green and the Admitted Prior Art raises a substantial new question of patentability as to claims 1 and 2 of Buck. Page 11, lines 1-3, and the claim chart at pages 18-37 of the request for reexamination are hereby incorporated by reference for their explanation of the teaching provided in Schaffrath and Green and the Admitted Prior Art that was not present in the prosecution of the application which became the Buck patent. There is a substantial likelihood that a reasonable examiner would consider this teaching important in deciding whether or not claims 1 and 2 of Buck were patentable. Accordingly, the combination of Schaffrath and Green and the Admitted Prior Art raises a substantial new question of patentability as to claims 1 and 2, which question has not been decided in a previous examination of the Buck patent.

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<sup>1</sup> In particular, requester cites col. 1, line 10 to col. 3, line 50 of Buck as admitted prior art, and this citation in Buck also cites Means, Baumann, and Bubik. See the paragraph bridging pages 9 and 10 of the request; and, for example, the claim chart on pages 18-23, where the Admitted Prior Art refers to cited portions in Buck and also refers to Means, Baumann, and Bubik.

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90/008,932  
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**5. The request indicates the Requester considers that the combination of Verti-Forma '67 and the Admitted Prior Art raises a substantial new question of patentability with respect to claims 1 and 2 of Buck.**

It is agreed that consideration of the combination of Verti-Forma '67 and the Admitted Prior Art raises a substantial new question of patentability as to claims 1 and 2 of Buck. Page 11, lines 4-6, and the claim chart at pages 37-57 of the request for reexamination are hereby incorporated by reference for their explanation of the teaching provided in Verti-Forma '67 and the Admitted Prior Art that was not present in the prosecution of the application which became the Buck patent. There is a substantial likelihood that a reasonable examiner would consider this teaching important in deciding whether or not claims 1 and 2 of Buck were patentable. Accordingly, the combination of Verti-Forma '67 and the Admitted Prior Art raises a substantial new question of patentability as to claims 1 and 2, which question has not been decided in a previous examination of the Buck patent.

**6. The request indicates the Requester considers that the combination of Verti-Forma '76 and the Admitted Prior Art raises a substantial new question of patentability with respect to claims 1 and 2 of Buck.**

It is agreed that consideration of the combination of Verti-Forma '76 and the Admitted Prior Art raises a substantial new question of patentability as to claims 1 and 2 of Buck. Page 11, lines 7-9, and the claim chart at pages 57-77 of the request for reexamination are hereby incorporated by reference for their explanation of the teaching

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90/008,932  
Art Unit: 3991

Page 6

provided in Verti-Forma '76 and the Admitted Prior Art that was not present in the prosecution of the application which became the Buck patent. There is a substantial likelihood that a reasonable examiner would consider this teaching important in deciding whether or not claims 1 and 2 of Buck were patentable. Accordingly, the combination of Verti-Forma '76 and the Admitted Prior Art raises a substantial new question of patentability as to claims 1 and 2, which question has not been decided in a previous examination of the Buck patent.

**7. The request indicates the Requester considers that the combination of Parker and the Admitted Prior Art raises a substantial new question of patentability with respect to claims 1 and 2 of Buck.**

It is agreed that consideration of the combination of Parker and the Admitted Prior Art raises a substantial new question of patentability as to claims 1 and 2 of Buck. Page 11, lines 10-12, and the claim chart at pages 77-96 of the request for reexamination are hereby incorporated by reference for their explanation of the teaching provided in Parker and the Admitted Prior Art that was not present in the prosecution of the application which became the Buck patent. There is a substantial likelihood that a reasonable examiner would consider this teaching important in deciding whether or not claims 1 and 2 of Buck were patentable. Accordingly, the combination of Parker and the Admitted Prior Art raises a substantial new question of patentability as to claims 1 and 2, which question has not been decided in a previous examination of the Buck patent.

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90/008,932  
Art Unit: 3991

Page 7

#### ***Duty to Disclose***

8. The patent owner is reminded of the continuing responsibility under 37 CFR 1.565(a) to apprise the Office of any litigation activity, or other prior or concurrent proceeding, involving Patent No. 5,500,932 throughout the course of this reexamination proceeding. The third party requestor is also reminded of the ability to similarly apprise the Office of any such activity or proceeding throughout the course of this reexamination proceeding. See MPEP §§ 2207, 2282 and 2286.

#### ***Correspondence***

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alan Diamond whose telephone number is (571) 272-1338. The examiner can normally be reached on Monday through Friday from 5:30 a.m. to 2:00 p.m.

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Application/Control Number:  
90/008,932  
Art Unit: 3991

Page 8

***Notice Re Patent Owner's Correspondence Address***

Effective May 16, 2007, 37 CFR 1.33(c) has been revised to provide that:

The patent owner's correspondence address for all communications in an *ex parte* reexamination or an *inter partes* reexamination is designated as the correspondence address of the patent.

*Revisions and Technical Corrections Affecting Requirements for Ex Parte and Inter Partes Reexamination, 72 FR 18892 (April 16, 2007)(Final Rule)*

**The correspondence address for any pending reexamination proceeding not having the same correspondence address as that of the patent is, by way of this revision to 37 CFR 1.33(c), automatically changed to that of the patent file as of the effective date.**

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Parties are to take this change into account when filing papers, and direct communications accordingly.

In the event the patent owner's correspondence address listed in the papers (record) for the present proceeding is different from the correspondence address of the patent, it is strongly encouraged that the patent owner affirmatively file a Notification of Change of Correspondence Address in the reexamination proceeding and/or the patent (depending on which address patent owner desires), to conform the address of the proceeding with that of the patent and to clarify the record as to which address should be used for correspondence.

Telephone Numbers for reexamination inquiries:

Reexamination and Amendment Practice	(571) 272-7703
Central Reexam Unit (CRU)	(571) 272-7705
Reexamination Facsimile Transmission No.	(571) 273-9900

Application/Control Number:  
90/008,932  
Art Unit: 3991

Page 9

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Alexandria VA 22313-1450

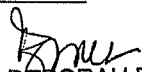
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Central Reexamination Unit

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Attn: Central Reexamination Unit  
Randolph Building, Lobby Level  
401 Dulany Street  
Alexandria, VA 22314

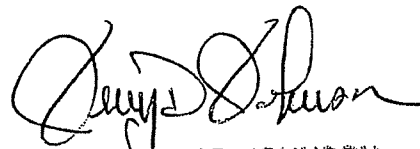
Signed:



Alan Diamond  
Primary Examiner  
Art Unit 3991  
(571) 272-1338



DEBORAH D. JONES  
CRU SPE-AU 3991



JERRY D. JOHNSON  
PRIMARY EXAMINER  
CRU - AU 3991

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FORM PTO-1449  U.S. DEPARTMENT OF COMMERCE PATENT AND TRADEMARK OFFICE  INFORMATION DISCLOSURE STATEMENT BY APPLICANT  (Sheet 1 of 2)				ATTY. DOCKET NO.		SERIAL NO. <b>DEC 26 2007</b> Not yet known Reexamination of U.S. Patent 5,500,091	
				Bück <i>et al.</i>			
				FILING DATE Not yet known 11/16/2007		GROUP Central Reexamination Unit 3991	
U.S. PATENT DOCUMENTS							
EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUBCLASS	FILING DATE IF APPROPRIATE
FOREIGN PATENT DOCUMENTS							
		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUBCLASS	TRANSLATION YES NO
/AD/		GB 1,125,906	10/29/1964	United Kingdom	—	—	— —
/AD/		DE 31 38 133	09/25/1981	Federal Republic of Germany	—	—	✓ —
OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, Etc.)							
/AD/	1	Schaffrath, P.M. and Green, M.S. "Vertical Forming Machine Gives Symmetrical Sheet Structure." (May 1965) TAPPI 48(5): 50A-52A.					
/AD/	2	"Paper Machine Felts." Ed. Woodside, L.M. (1967) Albany Felt Company, Albany, NY: Chapter IV, pages 17-22.					
/AD/	3	"Paper Machine Felts and Fabrics" Eds. Bergsma, et al. (1976) Albany International Corp., Albany, NY: Chapter 4, pages 35-43.					
/AD/	4	Parker, J.D. "The Sheet Forming Process." (1972) TAPPI Fourth Printing: 80-89.					
EXAMINER /Alan Diamond/				DATE CONSIDERED 12/17/2007			

EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

EXHIBIT K



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FORM PTO-1449  U.S. DEPARTMENT OF COMMERCE PATENT AND TRADEMARK OFFICE  INFORMATION DISCLOSURE STATEMENT BY APPLICANT  (Sheet 2 of 2)				ATTY. DOCKET NO.		SERIAL <del>Not yet known</del> 5,500,091 Reexamination of U.S. patent 5,500,091	
				Bück et al.			
				FILING DATE <del>Not yet known</del> 11/16/2007		GROUP Central Reexamination Unit 3991	
U.S. PATENT DOCUMENTS							
EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUBCLASS	FILING DATE IF APPROPRIATE
FOREIGN PATENT DOCUMENTS							
		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUBCLASS	TRANSLATION YES NO
OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, Etc.)							
/AD/	5	Baumann, W. "DUOFORMER-D® - A New Approach to Top Wire Forming." (1988) TAPPI Proceedings – Annual Meeting: 75-80.					

EXAMINER /Alan Diamond/	DATE CONSIDERED 12/17/2007
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EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

EXHIBIT K

# **Exhibit 11**



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
www.uspto.gov

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VOLPE & KOENIG, P.C.

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Volpe and Koenig, P.C.  
United Plaza, Suite 1600  
30 South 17<sup>th</sup> Street  
Philadelphia, PA 19103

## EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/008,931.

PATENT NO. 5,853,544.

ART UNIT 3991.

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified *ex parte* reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the *ex parte* reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).

<b>Order Granting / Denying Request For Ex Parte Reexamination</b>	<b>Control No.</b>	<b>Patent Under Reexamination</b>	
	90/008,931	5,853,544	
	<b>Examiner</b>	<b>Art Unit</b>	
	Alan Diamond	3991	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

The request for *ex parte* reexamination filed 16 November 2007 has been considered and a determination has been made. An identification of the claims, the references relied upon, and the rationale supporting the determination are attached.

Attachments: a) ☐ PTO-892, b) ☒ PTO/SB/08, c) ☐ Other: \_\_\_\_\_

1. ☒ The request for *ex parte* reexamination is GRANTED.

**RESPONSE TIMES ARE SET AS FOLLOWS:**

For Patent Owner's Statement (Optional): TWO MONTHS from the mailing date of this communication (37 CFR 1.530 (b)). **EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).**

For Requester's Reply (optional): TWO MONTHS from the **date of service** of any timely filed Patent Owner's Statement (37 CFR 1.535). **NO EXTENSION OF THIS TIME PERIOD IS PERMITTED.** If Patent Owner does not file a timely statement under 37 CFR 1.530(b), then no reply by requester is permitted.

2. ☐ The request for *ex parte* reexamination is DENIED.

This decision is not appealable (35 U.S.C. 303(c)). Requester may seek review by petition to the Commissioner under 37 CFR 1.181 within ONE MONTH from the mailing date of this communication (37 CFR 1.515(c)). **EXTENSION OF TIME TO FILE SUCH A PETITION UNDER 37 CFR 1.181 ARE AVAILABLE ONLY BY PETITION TO SUSPEND OR WAIVE THE REGULATIONS UNDER 37 CFR 1.183.**

In due course, a refund under 37 CFR 1.26 ( c ) will be made to requester:

- a) ☐ by Treasury check or,  
b) ☐ by credit to Deposit Account No. \_\_\_\_\_, or  
c) ☐ by credit to a credit card account, unless otherwise notified (35 U.S.C. 303(c)).

Alan Diamond  
Primary Examiner  
Art Unit: 3991

cc:Requester ( if third party requester )

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***Decision on Reexamination Request***

1. A substantial new question of patentability affecting claims 1 and 2 of United States Patent Number 5,853,544 to Egelhof *et al.* (hereinafter "Egelhof") is raised by the request for *ex parte* reexamination. The request for reexamination is Third Party requested.

***Extension of Time***

2. Extensions of time under 37 CFR 1.136(a) will not be permitted in these proceedings because the provisions of 37 CFR 1.136 apply only to "an applicant" and not to parties in a reexamination proceeding. Additionally, 35 U.S.C. 305 requires that *ex parte* reexamination proceedings "will be conducted with special dispatch" (37 CFR 1.550(a)). Extensions of time in *ex parte* reexamination proceedings are provided for in 37 CFR 1.550(c).

***Substantial New Question of Patentability (SNQ)***

3. The presence or absence of a "substantial new question of patentability" determines whether or not reexamination is ordered.

For a "substantial new question of patentability" to be present, it is only necessary that :

A) the prior art patents and/or printed publications raise a substantial new question of patentability regarding at least one claim, i.e., the teaching of the (prior art)

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patents and printed publications is such that a reasonable examiner would consider the teaching to be important in deciding whether or not the claim is patentable; and

B) the same question of patentability as to the claim has not been decided by the Office in a previous examination of the patent or in a final holding of invalidity by the Federal Courts in a decision on the merits involving the claim.

A SNQ may be based solely on old art where the old art is being presented/viewed in a new light, or in a different way, as compared with its use in the earlier concluded examination(s), in view of a material new argument or interpretation in the request. (MPEP 2242).

#### ***References Relied Upon in the Request***

Schaffrath, P.M. and Green, M.S. "Vertical Forming Machine Gives Symmetrical Sheet Structure." (May 1965) TAPPI 48(5): 50A-52A, (hereinafter "Schaffrath and Green"), newly cited.

"Paper Machine Felts." Ed. Woodside, L.M. (1967), Albany Felt Company; Albany, NY: Chapter IV, pages 17-22, (hereinafter "Verti-Forma '67"), newly cited.

"Paper Machine Felts and Fabrics." Eds. Bergsma, *et al.* (1976) Albany International Corp., Albany, NY: Chapter 4, pages 35-43, (hereinafter "Verti-Forma '76"), newly cited.

Parker, J.D. "The Sheet Forming Process." (1972) TAPPI Fourth Printing: 80-89. (hereinafter "Parker"), newly cited.

Norman, B. "Principles of Twin-Wire Forming," Svensk Papperstidning, 8(11), pages 330-336, (1979), newly cited.

Means, GB 1,125,906, old art.

Baumann, W. "DUOFORMER-D® - A new Approach to Top Wire Forming." (1988) TAPPI Proceedings – Annual Meeting: pp. 75-80 (hereinafter "Baumann"), newly cited.

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Bubik, DE 3138133 A1, old art.

***Request***

**4. The request indicates the Requester considers that the combination of Schaffrath and Green, Norman, admissions in Egelhof, Means, Baumann and Bubik raises a substantial new question of patentability with respect to claims 1 and 2 of Egelhof. The Requester refers collectively to said admissions in Egelhof, Means, Baumann and Bubik as "Admitted Prior Art"<sup>1</sup>, and the same terminology is used herein.**

It is agreed that consideration of the combination of Schaffrath and Green, Norman and the Admitted Prior Art raises a substantial new question of patentability as to claims 1 and 2 of Egelhof. Page 12, lines 7-10, and the claim chart at pages 20-34 of the request for reexamination are hereby incorporated by reference for their explanation of the teaching provided in Schaffrath and Green, Norman and the Admitted Prior Art that was not present in the prosecution of the application which became the Egelhof patent. There is a substantial likelihood that a reasonable examiner would consider this teaching important in deciding whether or not claims 1 and 2 of Egelhof were patentable. Accordingly, the combination of Schaffrath and Green, Norman and the Admitted Prior Art raises a substantial new question of patentability as to claims 1 and 2, which question has not been decided in a previous examination of the Egelhof patent.

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**5. The request indicates the Requester considers that the combination of Verti-Forma '67, Norman and the Admitted Prior Art raises a substantial new question of patentability with respect to claims 1 and 2 of Egelhof.**

It is agreed that consideration of the combination of Verti-Forma '67, Norman and the Admitted Prior Art raises a substantial new question of patentability as to claims 1 and 2 of Egelhof. Page 12, lines 11-14, and the claim chart at pages 34-48 of the request for reexamination are hereby incorporated by reference for their explanation of the teaching provided in Verti-Forma '67, Norman and the Admitted Prior Art that was not present in the prosecution of the application which became the Egelhof patent. There is a substantial likelihood that a reasonable examiner would consider this teaching important in deciding whether or not claims 1 and 2 of Egelhof were patentable. Accordingly, the combination of Verti-Forma '67, Norman and the Admitted Prior Art raises a substantial new question of patentability as to claims 1 and 2, which question has not been decided in a previous examination of the Egelhof patent.

**6. The request indicates the Requester considers that the combination of Verti-Forma '76, Norman and the Admitted Prior Art raises a substantial new question of patentability with respect to claims 1 and 2 of Egelhof.**

It is agreed that consideration of the combination of Verti-Forma '76, Norman and the Admitted Prior Art raises a substantial new question of patentability as to claims 1

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<sup>1</sup> In particular, requester cites col. 1, line 16 to col. 3, line 56 of Egelhof as admitted prior art, and this citation in Egelhof also cites Means, Baumann and Bubik. See the paragraph bridging pages 10 and 11 of the request; and, for example, the claim chart on pages 20-24, where the Admitted Prior Art refers to cited portions in Egelhof and also refers to Means, Baumann and Bubik.



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and 2 of Egelhof. Page 12, lines 15-18, and the claim chart at pages 49-63 of the request for reexamination are hereby incorporated by reference for their explanation of the teaching provided in Verti-Forma '76, Norman and the Admitted Prior Art that was not present in the prosecution of the application which became the Egelhof patent.

There is a substantial likelihood that a reasonable examiner would consider this teaching important in deciding whether or not claims 1 and 2 of Egelhof were patentable. Accordingly, the combination of Verti-Forma '76, Norman and the Admitted Prior Art raises a substantial new question of patentability as to claims 1 and 2, which question has not been decided in a previous examination of the Egelhof patent.

**7. The request indicates the Requester considers that the combination of Parker, Norman and the Admitted Prior Art raises a substantial new question of patentability with respect to claims 1 and 2 of Egelhof.**

It is agreed that consideration of the combination of Parker, Norman and the Admitted Prior Art raises a substantial new question of patentability as to claims 1 and 2 of Egelhof. Page 12, lines 19-22, and the claim chart at pages 63-77 of the request for reexamination are hereby incorporated by reference for their explanation of the teaching provided in Parker, Norman and the Admitted Prior Art that was not present in the prosecution of the application which became the Egelhof patent. There is a substantial likelihood that a reasonable examiner would consider this teaching important in deciding whether or not claims 1 and 2 of Egelhof were patentable. Accordingly, the combination of Parker, Norman and the Admitted Prior Art raises a substantial new question of

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patentability as to claims 1 and 2, which question has not been decided in a previous examination of the Egelhof patent.

#### ***Duty to Disclose***

8. The patent owner is reminded of the continuing responsibility under 37 CFR 1.565(a) to apprise the Office of any litigation activity, or other prior or concurrent proceeding, involving Patent No. 5,853,544 throughout the course of this reexamination proceeding. The third party requestor is also reminded of the ability to similarly apprise the Office of any such activity or proceeding throughout the course of this reexamination proceeding. See MPEP §§ 2207, 2282 and 2286.

#### ***Correspondence***

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alan Diamond whose telephone number is (571) 272-1338. The examiner can normally be reached on Monday through Friday from 5:30 a.m. to 2:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones can be reached on (571) 272-1535.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

***Notice Re Patent Owner's Correspondence Address***

Effective May 16, 2007, 37 CFR 1.33(c) has been revised to provide that:

The patent owner's correspondence address for all communications in an *ex parte* reexamination or an *inter partes* reexamination is designated as the correspondence address of the patent.

*Revisions and Technical Corrections Affecting Requirements for Ex Parte and Inter Partes Reexamination, 72 FR 18892 (April 16, 2007)(Final Rule)*

**The correspondence address for any pending reexamination proceeding not having the same correspondence address as that of the patent is, by way of this revision to 37 CFR 1.33(c), automatically changed to that of the patent file as of the effective date.**

This change is effective for any reexamination proceeding which is pending before the Office as of May 16, 2007, including the present reexamination proceeding, and to any reexamination proceeding which is filed after that date.

Parties are to take this change into account when filing papers, and direct communications accordingly.

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In the event the patent owner's correspondence address listed in the papers (record) for the present proceeding is different from the correspondence address of the patent, it is strongly encouraged that the patent owner affirmatively file a Notification of Change of Correspondence Address in the reexamination proceeding and/or the patent (depending on which address patent owner desires), to conform the address of the proceeding with that of the patent and to clarify the record as to which address should be used for correspondence.

Telephone Numbers for reexamination inquiries:

Reexamination and Amendment Practice	(571) 272-7703
Central Reexam Unit (CRU)	(571) 272-7705
Reexamination Facsimile Transmission No.	(571) 273-9900

Please mail any communications to:  
Attn: Mail Stop "Ex Parte Reexam"  
Central Reexamination Unit  
Commissioner for Patents  
P. O. Box 1450  
Alexandria VA 22313-1450

Please FAX any communications to:  
(571) 273-9900  
Central Reexamination Unit

Please hand-deliver any communications to:  
Customer Service Window  
Attn: Central Reexamination Unit  
Randolph Building, Lobby Level  
401 Dulany Street  
Alexandria, VA 22314

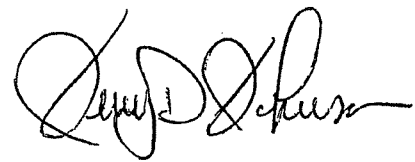
Signed:



Alan Diamond  
Primary Examiner  
Art Unit 3991  
(571) 272-1338



DEBORAH D. JONES  
CRU SPE-AU 3991



JERRY D. JOHNSON  
PRIMARY EXAMINER  
CRU - AU 3991

FORM PTO-1449  U.S. DEPARTMENT OF COMMERCE PATENT AND TRADEMARK OFFICE  INFORMATION DISCLOSURE STATEMENT BY APPLICANT  (Sheet 1 of 2)				ATTY. DOCKET NO.		SERIAL NO. <b>DEC/2</b> Not yet known Reexamination of Patent 5,853,544		
				Egelhof <i>et al.</i>				
				FILING DATE Not yet known 11/18/2007		GROUP Central Reexamination Unit 3991		
U.S. PATENT DOCUMENTS								
EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUBCLASS	FILING DATE IF APPROPRIATE	
FOREIGN PATENT DOCUMENTS								
		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUBCLASS	TRANSLATION	
							YES	NO
/AD/		GB 1,125,906	10/29/1964	United Kingdom	—	—	—	—
/AD/		DE 31 38 133	09/25/1981	Federal Republic of Germany	—	—	✓	
OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, Etc.)								
/AD/	1	Schaffrath, P.M. and Green, M.S. "Vertical Forming Machine Gives Symmetrical Sheet Structure." (May 1965) TAPPI 48(5): 50A-52A.						
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/AD/	4	Parker, J.D. "The Sheet Forming Process." (1972) TAPPI Fourth Printing: 80-89.						
EXAMINER /Alan Diamond/				DATE CONSIDERED 12/17/2007				

EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

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FORM PTO-1449  U.S. DEPARTMENT OF COMMERCE PATENT AND TRADEMARK OFFICE  INFORMATION DISCLOSURE STATEMENT BY APPLICANT  (Sheet 2 of 2)	ATTY. DOCKET NO.	SERVING Not yet known Reexamination of U.S. patent 5,853,544
	Egelhof <i>et al.</i>	
	FILING DATE Not yet known 11/16/2007	GROUP Central Reexamination Unit 3991

## U.S. PATENT DOCUMENTS

EXAMINER INITIAL	DOCUMENT NUMBER	DATE	NAME	CLASS	SUBCLASS	FILING DATE IF APPROPRIATE

## FOREIGN PATENT DOCUMENTS

EXAMINER INITIAL	DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUBCLASS	TRANSLATION	
						YES	NO

## OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, Etc.)

/AD/	5	Baumann, W. "DUOFORMER-D® - A New Approach to Top Wire Forming." (1988) TAPPI Proceedings - Annual Meeting: 75-80.
/AD/		Norman, B. "Principles of twin-wire forming." Svensk Papperstidning (1979) 82 (11), 330-336.

EXAMINER /Alan Diamond/	DATE CONSIDERED 12/17/2007
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EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

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